UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Ex parte GORDON J. FREEMAN and ANAKANTH ANUMANTHAN

Appeal No. 2004-2339
Application No. 09/900,596

ON BRIEF

Before WILLIAM F. SMITH, SCHEINER, and ADAMS, Administrative Patent Judges.

WILLIAM F. SMITH, Administrative Patent Judge.

DECISION ON APPEAL

This is an appeal under 35 U.S.C. § 134 from the examiner's final rejection of claims 1-3, 5-12, 14, 16, 17, and 19-24. Subsequently, the examiner withdrew the rejection of claims 3, 6, 7, 9, 10, 14, and 24. Thus, claims 1, 2, 5, 8, 11, 12, 16, 17, and 19-23 are before us for a review. In addition, claims 4, 13, and 25-30 are pending but have been withdrawn from consideration by the examiner.

Claim 1 is representative of the subject matter on appeal and reads as follows:

1. A composition for treatment of pollution comprising:

a first component comprising a non-toxic, non-flammable, microorganism assimilable carbon containing substance in an oil phase;

a second component comprising a non-toxic nutrient in a water phase, the second component being formed as an emulsion within the first component; and

a third component comprising a diluent added to the first and second components, the diluent comprising a non-toxic, non-flammable, microorganism assimilable carbon containing compound which is soluble in the first component and is selected to facilitate viscosity stabilization for extended storage,

wherein the combination of the first, second and third components provide an initial source for culturing microorganisms present in a pollution site being treated.

The sole issue before us for review is whether claims 1, 2, 5, 8, 11, 12, 16, 17, and 19-23 are unpatentable under 35 U.S.C. § 102(b) on the basis of Freiesleben, U.S. Patent Number 5,171,475. We reverse.

Discussion

Claim 1 is directed to a composition for treatment of pollution that comprises first, second, and third components. The first component comprises a non-toxic, non-flammable, microorganism assimilable carbon containing substance in an oil phase. The second component comprises a non-toxic nutrient in a water phase. The third component comprises a specified diluent. The second component is formed as an emulsion within the first component and the diluent is added to the first and second components.

The examiner refers the reader of the Examiner's Answer to "prior Office Action, Paper No. 5/13/03" for the facts and reasons relied upon to support the § 102(b) rejection before us for review. Following the examiner's instructions, we find from that paper the examiner's position is:

> Freiesleben teaches water in oil microemulsions (title; abstract; column 4, line 20). Organic solvents comprising 2-(2-butoxyethoxy)

> ethanol are disclosed (claim 6). Compounds containing nitrogen are specified (Table 2). Waxes are disclosed (Table 1). 30% butyl carbitol is specified (Table 3).
>
> As to the claimed properties, the anticipatory compositions must possess them because it is the same composition as that claimed.

Office Action, Paper No. 7, page 3.

First, the examiner has not identified which components described in Freiesleben are considered to be the first, second, and third components required by claim 1 on appeal. More problematic, however, is the failure of the examiner to point to any specific disclosure in Freiesleben that describes a composition meeting the requirements of the claims. Instead the examiner has merely pointed to isolated disclosures in Freiesleben describing certain compounds.

For the present rejection under 35 U.S.C. § 102(b) to be proper, Freiesleben "must clearly and unequivocally disclose the claimed [composition] or direct those skilled in the art to the [composition] without any need for picking, choosing, and combining various disclosures not directly related to each other by the teachings of the cited reference." In re Arkley, 455 F.2d 586, 587, 172 USPQ 524, 526 (CCPA 1972) The court went on to state "[s]uch picking and choosing may be entirely proper in the making of a 103, obviousness rejection, where the applicant must be afforded an opportunity to rebut with objective evidence any inference of obviousness which may arise from the similarity of the subject matter which he claims to the prior art, but has no place in the making of a 102, anticipation rejection." Id.

Absent a clearer explanation from the examiner as to how Freiesleben identically discloses a composition in accordance with claim 1 on appeal, we cannot say that the examiner has made out a prima facie case of anticipation.

By way of example only, the need for the examiner to be more specific in explaining how the reference describes a composition within the metes and bounds of claim 1 on appeal concerns the requirement of claim 1 that the second component comprise a non-toxic nutrient in a water phase. At best, the examiner explains that the nitrogen containing emulsifiers described in Freiesleben "will be located at the oil/water interface as is well-known for the behavior of such compounds." Examiner's Answer, page 5. It is not apparent why the examiner considers a component that is located at oil/water interface would be considered to be "in a water phase" as required by claim 1 on appeal.

Furthermore, where the nitrogen containing emulsifiers of the reference are located in the composition is a core factual finding that underpins the examiner's conclusion of anticipation. Here, the examiner has only asserted that it is "well known" that the emulsifiers will be located at the oil/water interface. As stated in In re Zurko, 258 F.3d 1379, 1385-86, 59 USPQ2d 1693, 1697 (Fed. Cir. 2001), "the Board must point to some concrete evidence in the record" to support such a finding, rather than relying upon our assessment of what is "well recognized" or what a skilled artisan would be "well aware." Nor can facts relied upon in reaching a conclusion of unpatentability be based upon "subjective belief and unknown authority." See In re Lee, 277 F.3d 1338, 1344, 61 USPQ2d 1430, 1434 (Fed. Cir 2002).

The examiner's decision is reversed.

REVERSED

William F. Smith
Administrative Patent Judge

Toni R. Scheiner
Administrative Patent Judge

Donald E. Adams
Administrative Patent Judge

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